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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,483

11/14/2006

Matthias Fies

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

02/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,483	<b>Applicant(s)</b> FIES ET AL.	
	<b>Examiner</b> ROBERT SELLERS	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 8-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>17 October 2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 8-14, drawn to a composition comprising a mixture of (meth)acrylic compounds containing from 1 to 35% by weight of epoxy (meth)acrylates.

Group II, claims 15-24, drawn to a flattening composition containing a mixture of (meth)acrylic compounds containing from 1 to 35% by weight of epoxy (meth)acrylates and a dimerdiol.

Group III, claim 25, drawn to a glass material coated with the composition of Group II.

Group IV, claim 26, drawn to a process for the production of a mixture of (meth)acrylic compounds containing from 1 to 35% by weight of epoxy(meth)acrylates.

2. The inventions listed as Groups I to IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. The special technical feature is the mixture of (meth)acrylic compounds containing from 1 to 35% by weight of epoxy (meth)acrylates.
3. The term "epoxy (meth)acrylate" is open to any compound or monomer containing epoxy and (meth)acryloyl functionalities. The epoxy (meth)acrylate obtainable by steps a), b) and c) of claim 8 is a product-by-process claim wherein the epoxy (meth)acrylate is based on the compound itself and not its method of production.

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4. According to MPEP § 2113, Product-by-Process Claims: Product-By-Process Claims are not Limited to the Manipulations of the Recited Steps, Only the Structure Implied by the Steps: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (*In re Thorpe*, 227 USPQ 964, 966, Federal Circuit 1985). "[T]he burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product." (MPEP § 2113, Burden Shifts to the Applicant to Show an Unobvious Difference and *In re Marosi*, 218 USPQ 289, 292, Federal Circuit 1983).

5. Japanese Patent No. 2000-338624 (Derwent abstract, second page, Coating liquid (B)) shows a blend of butyl acrylate, styrene, glycidyl acrylate within the claimed epoxy (meth)acrylate and hexamethylene-1,6-bis(ethylene urea). It would have been obvious to employ the glycidyl acrylate in an amount within the claimed parameters among the three other components to enhance the adhesion.

Accordingly, the special technical feature does not make a contribution over the prior art, thereby validating a holding of lack of unity.

6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

a) The hydroxyl compounds such as the reaction of the addition product of ethylene oxide and trimethylolpropane with adipic acid produced in Example 1 on page 9 of the specification.

b) The epoxides such as the bisphenol A diglycidyl ether of Example 2 on page 10.

c) Contingent upon the election of Group II, items a) and b) hereinabove and the dimerdiols such as the dimerdiol diacrylate of Example 3 on page 10.

7. Applicant is required, in reply to this action, to elect a single species ***within each of items a) and b), and c) if appropriate***, to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 8-26 are generic.

8. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical feature for the reasons espoused with respect to the holding of lack of unity hereinabove.

9. The term "obtainable" used to characterize the process of preparing the epoxy (meth)acrylates is indefinite due to its vagueness which opens the claims to epoxy (meth)acrylates obtained by methods not disclosed. The term should be amended to "obtained" to more declaratively define how the epoxy (meth)acrylates are produced.

10. There is no antecedent basis for "excess" acrylic and/or methacrylic acid of step c) since step a) does not require the esterification of the hydroxyl compounds with excess acrylic and/or methacrylic acid.

The prior art made of record and not relied upon is considered pertinent to the disclosure.

11. The abstracts for European Patent No. 126,341 cited in the Information Disclosure Statement filed October 17, 2005 set forth the reaction of residual (meth)acrylic acid from the (meth)acrylate ester of polyesters with an equivalent amount of a polyepoxide.

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Monday to Friday, 9:30 to 6:00

/Robert Sellers/  
Primary Examiner  
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rs 2/6/2009